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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,230	11/13/2003	Kelly Kleinman	Celebrity.01	9481

23616 7590 03/09/2004

LAW OFFICES OF CLEMENT CHENG
17220 NEWHOPE STREET #127
FOUNTAIN VALLEY, CA 92708

EXAMINER

MILLER, BENA B

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/712,230	Applicant(s) KLEINMAN, KELLY	
	Examiner Bena Miller	Art Unit 3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-18 is/are rejected.
- 7) ☒ Claim(s) 9 and 19 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear how the functional limitations of the claim further structurally limit the claimed apparatus. For example, it is not clear how the functional limitation "the front and rear half shell housing are painted" further structurally limit the apparatus. It appears that the claims recite a method.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 10-16^{1B} are rejected under 35 U.S.C. 103(a) as being unpatentable over Terzian in view of Mills and Pracas.

Terzian teaches in the figures most of the elements of the claimed invention, including a push button (308), three 1.5V batteries (col. 3, par.1). However, Terzian fails to teach a celebrity body and an electronic voice recording chip. Regarding claims 1, 10, 7 and 16, Mills teaches in figures 1-3 a method for making a doll having an image

Art Unit: 3712

impregnated thereon. Mills teaches that facial image of the doll could be of oneself and the body type image of a celebrity figure (col. 4, par. 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a celebrity body as taught by Mills for the figurine body of Terzian for the purpose of simulating a real image of a celebrity.

Regarding claims 1 and 10, Pracas teaches a doll having a microphone and sound recording device (44) along with a sound playback device and speaker (Abstract, lines 1 and 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a sound recording device as taught by Pracas for the figurine of Terzian for the purpose of playing a particular person's voice.

Regarding claims 2 and 11, Terzian fails to teach the speaker grille holes in the back head of the figurine. Terzian teaches speaker grille holes 28 formed in the chest of the doll (fig.10). It would have been obvious matter of design choice to place the grille holes in the back head of the figurine, since applicant has not disclosed that placing grille holes in the back of the figurine's head solves any stated problem or is for any particular purpose.

Regarding claims 3 and 12, Terzian may not teach the upper portion head is larger than the lower portion body. It would have been obvious matter of design choice to have the upper portion head larger than the lower portion body, since applicant has not disclosed that having the upper portion head larger than the lower portion body solves any stated problem or is for any particular purpose.

Regarding claims 4, 13, 5 and 14, it would have been obvious matter of design choice to have the figurine as a sports player appearing in his/her team uniform and speaking in his/her own voice, since applicant has not disclosed that having the figurine as a sports player appearing in his/her team uniform and speaking in his/her own voice, solves any stated problem or is for any particular purpose.

Regarding claims 8 and 18, Terzain fails to teach an upper circuit board and a lower circuit board. It would have been obvious to one having ordinary skill in the art at the time the invention was made to having an upper and lower circuit board, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terzian in view of Mills and Pracas as applied to claims 1 and 10 above, and further in view of Chang.

Terzian, Mills and Pracas teaches most of the elements of the claimed invention except for the a key chain attachment means. Chang teaches that it is well known to have a toy, such as a doll, attached to an opposite mounting end of the key chain (col. 1, lines 11-13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a key chain as taught by Chang with the figurine of Terzian, Mills and Pracas for aesthetic purposes.

Allowable Subject Matter

Claims 9 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hudock teaches a sports training device. Schuettenhelm et al teaches a musical doll.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 703.305.0643. The examiner can normally be reached on Monday-Friday.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Bena Miller
Examiner
Art Unit 3712

bbm
February 07, 2004